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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE MICHAEL MOCKRY and GREGORY MICHAEL
MOCKRY

Appeal 2009-001218¹
Application 09/878,860
Technology Center 3700

Decided:² August 3, 2009

Before RICHARD M. LEBOVITZ, JEFFREY N. FREDMAN, and
STEPHEN WALSH, *Administrative Patent Judges*.

Opinion for the Board filed by
FREDMAN, *Administrative Patent Judge*.

Opinion Concurring in part and Dissenting in part filed by
WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Heard June 9, 2009.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is an appeal under 35 U.S.C. § 134 involving claims to a method of editing a recorded baseball game. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

Statement of the Case

Background

The invention involves a “method of condensing the action portions of a baseball game or other sporting event, by recording the game on film or video tape, and editing it to retain the action portions.” (Spec. 1.) The edited version can be sold through a cable subscription or over the Internet.

(*Id.* at 2.)

The Claims

Claims 23-40, which are all the pending claims, are on appeal.

Claims 23, 24 and 27 are illustrative and read as follows:

23. A method of replaying or rebroadcasting a baseball game for which a video recording of the baseball game was produced containing substantially every pitch thrown to every batter from a first pitch to a final pitch and game action resulting from every pitch, together with other action occurring during each appearance by every batter, the method comprising
 - (a) editing the video recording to produce an edited recording, the edited recording having video consisting essentially of
 - (i) the final pitch thrown to every batter and any game action resulting from the final pitch,
 - (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and
 - (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch;
 - (b) obtaining subscribers for viewing the edited recording and

- (c) playing or broadcasting the edited recording for viewing by the subscribers.
24. A method of providing a subscription for viewing a recorded baseball game in which players from each team appear at bat, and attempt to place a pitched baseball into play and to reach base safely; with players failing to reach base safely being out and players on base attempting unsuccessfully to advance to another base being out; the method comprising:
- (1) recording each appearance-at-bat for every player and game action resulting from an appearance-at-bat to produce a game recording;
 - (2) editing the game recording of each appearance-at-bat to produce an edited recording by deleting substantially all game action other than
 - (i) game action from a final pitch thrown to each player,
 - (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and
 - (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch
 - (3) obtaining subscribers for viewing the edited recording and
 - (4) playing or broadcasting the edited recording as a condensed recorded game for viewing by the subscribers.
27. The method of claim 23 wherein said step of playing or broadcasting the edited recording for viewing is conducted over the Internet.

The prior art

Susan Slusser, *Producing SportsChannel 'Light' is Heavy Duty*, *San Francisco Chronicle*, July 18, 1997, at B3.

Kevin Berger, *Baseball Lite: All the hits without the fat*, July 26, 1995, at C1.

The issues

A. The Examiner rejected claims 23-25, 28-30, 33-35, 37-38 and 40 under 35 U.S.C. § 103 (a) as obvious over ProQuest-Producing Sports Channel (“Slusser”) (Ans. 2-6).

B. The Examiner rejected claims 27, 32, 36 and 39 under 35 U.S.C. § 103(a) as obvious over Slusser and MediaChannel (“Berger”) (Ans. 6).

The claims have not been argued separately and therefore stand or fall together. We select claims 23 and 24 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

A. and B. 35 U.S.C. § 103 (a) over Slusser and Berger

The Examiner found that the idea of an edited baseball game provided to subscribers was old in the art. (Ans. 3.) According to the Examiner, “it would have been obvious to one of ordinary skill in the art . . . to have selected an appropriate number of action shots recorded including substantially every pitch . . . in order to permit the edited video to be broadcast in an allotted time” (*Id.*) That is, a person of ordinary skill would have been aware that certain plays advance the game but others do not, and that person would have found it obvious to choose the most important actions for an edited recording. (*Id.* at 7-8.)

Appellants contend that “retaining substantially only the last pitch to each batter” is “NOT the production of a highlight show as that term is commonly understood.” (App. Br. 8.)³ Appellants contrast a highlight show

³ Citations are to the “Substitute Brief On Appeal” filed April 2, 2008.

that “edits a baseball game according to the subjective whims of the individual doing the editing,” with the claimed process that “requires a totally objective treatment of the baseball game.” (*Id.* at 9.) “The claimed method is not simply a matter of choice that varies from one time to another.” (*Id.* at 10.) “[T]he present invention provides a specific and consistent method or algorithm which can be applied to the editing of a baseball game.” (*Id.*) As Appellants see it, the prior art did not describe any specific method or specific way of editing a baseball game. (*Id.*) Appellants ask why Major League Baseball (MLB) characterized the claimed method as “revolutionary” if it was simply an obvious design choice, and argue that use by MLB is evidence of commercial success. (*Id.* at 16-18.)

In view of these conflicting positions, we frame the obviousness issues before us as follows:

(i) Have Appellants shown that the Examiner erred in finding that Slusser renders obvious a method of editing a baseball game resulting in an “edited recording having video consisting essentially of the final pitch thrown to every batter and any game action resulting from the final pitch” as required by claim 23?

(ii) Have Appellants shown that the Examiner erred in finding that Slusser renders obvious a method of editing a baseball game “to produce an edited recording by deleting substantially all game action other than (i) game action from a final pitch thrown to each player” as required by claim 24?

Findings of Fact

Slusser

1. The Slusser article is entitled “Producing SportsChannel ‘Light’ Is Heavy Duty.”

2. Slusser reported on “highlight shows, which condense A’s and Giants’ games into just a half-hour.”
3. According to Slusser, “[t]he gist of the program is to give a real flavor of the game, with as much of the pertinent action as possible.”
4. The show editor explained that “[w]alks cut into the program’s 22 minutes, and, well, aren’t very exciting.”
5. Slusser reported that “SportsChannel Pacific was the first outlet in the country to run an abbreviated baseball game; SportsChannel New York now has a version, thanks to Mark Shuken, who originated the idea with SportsChannel’s Larry Meyers before moving to New York.”

Berger

6. The Berger article is entitled “Baseball Lite: All the hits without the fat.”
7. The subtitle of Berger’s article is “Fast editing turns a game into a 1-hour SportsChannel show.”
8. Berger reported on “a venture by San Francisco-based cable TV station SportsChannel Pacific to condense an afternoon baseball game into one hour and televise it the same evening.”
9. Berger reported that the “game’s best action can be easily edited into one hour.”
10. Berger reported that the producer “instructs editor Armstrong to preserve the top of the first inning, the entire sixth inning, and the bottom of the ninth. Along with the graphics and Kuiper’s voice-overs, the condensed game will fit neatly on three separate videotapes.”

11. Berger reported that “in the fourth [inning], with Sox runners on first and third, Stottlemire fakes a throw to third and picks the runner off first . . . ‘There’s no time to keep that weird pickoff play now,’ says Winter. ‘Too bad.’”

Principles of Law

A rejection for obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), *quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). “[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . . . [I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 550 U.S. at 401. The proponent of commercial success must provide “hard evidence” of sales having a nexus to the claimed invention. *In re Huang*, 100 F.3d 1135, 140 (Fed. Cir. 1996).

“By using the term ‘consisting essentially of,’ the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.” *PPG Industries v. Guardian Industries Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998). To construe the phrase “consisting essentially of,” it is “necessary and proper to determine” the interpretation that the Specification reasonably supports. *In re Herz*, 537 F.2d 549, 551 (CCPA 1976).

Analysis

Claim 23

Representative claim 23 uses the phrase “edited recording having video consisting essentially of” three recited categories of game play. The term “consisting essentially of” signals that a claim is open to unlisted components which “do not materially affect the basic and novel properties of the invention.” Thus, we turn to the Specification to determine the basic and novel properties of the claimed invention. The Specification describes the edited recording in this passage:

The video record, which can be film, digital, or tape, is edited down to retain the last pitch thrown to each player, plus any resulting action for that pitch. This would record each safe base hit, each walk, strike out, sacrifice fly, ground out, etc. Of course, fielding would be recorded, i.e., each put-out, error, double-ply, and throw-out. The resulting video record would be about 10 to 15 minutes, showing all the action of the game. Base running activity (i.e., activity that can also result in either an out or advancement of the runner) can also be retained, such as stolen bases and attempted steals, pickoffs, rundowns, balks, and wild pitches. Some additional material (e.g., narrative) can be included to explain pitching changes, pinch runners, and other substitutions that may affect play.

(Spec., para. bridging pp. 1-2.) Thus, the Specification indicates that video editing, in addition to the three claimed categories of game play, could also include, e.g., “wild pitches”, “balks”, and “additional material” such as “narrative” materials. For this reason, we do not interpret “consisting essentially of” to exclude game play categories other than those explicitly recited in the claim because it does not appear the three constitute the basic and novel properties of the claimed invention.

We interpret “edited recording having video consisting essentially of” as necessarily including the three categories of action recited in claim 23, and as optionally including any additional action category listed in the quoted Specification passage.

Therefore, a broadcast of the entire game, edited to include instant replays or other materials, renders claim 23 obvious, since the edited recording will “consist essentially of” the last pitch thrown to each player and attempted base running activity, as required by the Specification and claim 23.

We are not persuaded by Appellants’ argument that the “claimed method is an objective procedure for producing a specific edited version of a baseball game in which every batter’s appearance at the plate is shown, where that appearance is edited such that the resulting video ‘consists essentially of’ the last pitch to each batter and the resulting action” (App. Br. 8). This argument requires a claim interpretation in which the transitional phrase “consisting essentially of” distinguishes the edited baseball game from a complete game, edited to show instant replays or other additional material, or edited to delete rain delays. However, as discussed above, there is no basis to interpret “consisting essentially of” so narrowly in light of the instant Specification.

Claim 24

The Examiner found that SportsChannel was showing edited baseball game video recordings to video subscribers via cable TV and via the Internet. Versions where the game was edited down to one hour or as short as 22 minutes were in use. (FF4; FF7.) The Examiner acknowledged that

the description of the SportsChannel game did not clearly disclose what game action was being edited out or left in the videotapes. (Ans. 7.)

However, Berger reported that the producer “instructs editor Armstrong to preserve the top of the first inning, the entire sixth inning, and the bottom of the ninth. Along with the graphics and Kuiper’s voice-overs, the condensed game will fit neatly on three separate videotapes” (FF 10). This suggests that game action other than the top of the first inning, the sixth inning, and the bottom of the ninth inning was not necessarily included in the edited video.

The Examiner concluded that it would have been obvious to an editor of ordinary skill editing a baseball video at the time of Appellants’ invention “to include the activities that were most important in deciding the game’s outcome.” (*Id.* at 8.) According to the Examiner, an editor’s “common sense” would have been to include the action segments that advance the game and leave out actions not important to the outcome of the game. (*Id.*) Thus, the Examiner concluded that Appellants’ methods would have been obvious, whether claimed in terms of an “edited recording having video consisting essentially of” the recited three kinds of action (claim 23), or written in terms of in terms of editing by “deleting substantially all game action other than” the recited three kinds of action (claim 24).

While the Examiner may “take account of the inferences and creative steps that a person of ordinary skill would employ.” *KSR*, 550 U.S. at 418, the Examiner provides no reason or evidence as to why the person of ordinary skill and ordinary creativity would have edited a baseball game “to produce an edited recording by deleting substantially all game action other

than (i) game action from a final pitch thrown to each player” as required by claim 24.

While we recognize that this editing was clearly within the skill of the ordinary artisan, even the cited prior art chose to exclude portions of the baseball game which would be required by claim 24. Claim 24 expressly requires that “unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch” be included in the edited game video. However, Berger reported that “in the fourth [inning], with Sox runners on first and third, Stottlemire fakes a throw to third and picks the runner off first . . . ‘There’s no time to keep that weird pickoff play now,’ says Winter. ‘Too bad.’” (FF 11).

We agree with Appellants that the “concept of making a highlight tape does not suggest making such a pre-selected, edited record of an entire baseball game in the manner defined by the pending claims” (App. Br. 14). Without the Appellants’ disclosure, we are not persuaded that the ordinary creative artisan would have reasonably considered including portions of a baseball game such as walks, which “aren’t very exciting. A dull ninth inning is also a downer” (FF 4). However, claim 24 requires the inclusion of uninteresting game elements such as a quick three out inning with three ground outs to second base. Consequently, there is no reason for the creative person of ordinary skill to have edited a baseball game as required by claim 24 to shorten the game but include boring game elements.

Conclusions of Law

(i) Appellants have not shown that the Examiner erred in finding that Slusser renders obvious a method of editing a baseball game resulting in an

“edited recording having video consisting essentially of the final pitch thrown to every batter and any game action resulting from the final pitch” as required by claim 23.

(ii) Appellants have shown that the Examiner erred in finding that Slusser renders obvious a method of editing a baseball game “to produce an edited recording by deleting substantially all game action other than (i) game action from a final pitch thrown to each player” as required by claim 24.

SUMMARY

We affirm the rejection of claim 23 under 35 U.S.C. § 103(a) over Slusser and over Slusser and Berger. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejection of claims 25, 27-30, and 32-40, as these claims were not argued separately.

We reverse the rejection of claim 24 under 35 U.S.C. § 103(a) over Slusser and over Slusser and Berger.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

Opinion concurring-in-part and dissenting-in-part, filed by STEPHEN WALSH, *Administrative Patent Judge*.

I concur with affirming the obviousness rejection of claims 23, 25, 27-30 and 32-40. However, I respectfully dissent from the decision to reverse the obviousness rejection of claim 24.

The Examiner acknowledged that the SportsChannel show descriptions did not clearly disclose what game action was being edited out

or left in the videotapes. (Ans. 7.) However, the Examiner found that one of ordinary skill in the art at the time of Appellants' invention would have been aware that in a typical baseball game, the plays that visibly advance the game are hits, runs, errors, stolen bases and outs. (*Id.*) The Examiner's finding of knowledge in the art is as follows:

If one looks at a typical baseball game, there are two types of plays that occur

A) Those actions that move the game forward to its conclusion and subsequently result in changing players on the field i.e. hits, runs, errors, stolen bases and outs.

B) Those actions that incrementally move the game forward without changing players on the field i.e. thrown balls and 1st and 2nd strikes.

The action in the game occurs within group A, not group B, since this is where there is a potential for the game to visibly advance. While the actions that occur in Group B, are important to the game, they remain static i.e. a ball is thrown by the pitcher and the batter either swings or does not swing at the ball. Essentially these actions are interchangeable with each other since they never result in changing the status of the players on the field.

(Ans. 7.) Appellants do not dispute that persons of ordinary skill in the art at the time of the invention would have had the game knowledge the Examiner attributed to them.

The Examiner concluded that it would have been obvious to an editor of ordinary skill editing a baseball video at the time of Appellants' invention "to include the activities that were most important in deciding the game's outcome." (*Id.* at 8.) According to the Examiner, an editor's "common sense" would have been to include the action segments that advance the game and leave out actions not important to the outcome of the game. (*Id.*) Thus, the Examiner concluded that Appellants' methods would have been

obvious, whether claimed in terms of an “edited recording having video consisting essentially of” the recited three kinds of action (claim 23), or written in terms of in terms of editing by “deleting substantially all game action other than” the recited three kinds of action (claim 24).

My colleagues find the Examiner gave no reason or evidence as to why the person of ordinary skill and ordinary creativity would have edited a baseball game according to claim 24. In my view, the Examiner’s finding that “[t]he action in the game occurs within group A, not group B, since this is where there is a potential for the game to visibly advance,” was sufficient. The Examiner’s undisputed findings of the level of skill and knowledge in the art, and objective analysis of the types of action to be selected by an editor having the ordinary level of skill and knowledge, provide context for weighing the “common sense” of the editor. *Cf. In re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002).

Appellants object that their method does not produce “a highlight show as that term is commonly understood.” (App. Br. 8.) Appellants contrast a highlight show that “edits a baseball game according to the subjective whims of the individual doing the editing,” with the claimed process that “requires a totally objective treatment of the baseball game.” (*Id.* at 9.) In the Final Rejection, the Examiner relied on the Merriam-Webster on-line dictionary definition of “highlight” as meaning “something (as an event or detail) that is of major significance or special interest.” (Fin. Rej. at 6.) Whether the claimed method produces a “highlight show” or not is beside the point. The issue is whether a step of editing to include essentially the game advancing action would have been obvious, whether the product recording is called a “highlight show” or not.

I agree that the “claimed method is not simply a matter of choice that varies from one time to another,” and that the “present invention provides a specific and consistent method or algorithm which can be applied to the editing of a baseball game.” (App. Br. at 10.) However, the issue is whether that selection method or algorithm would have been obvious. As the Examiner found, the claimed method selects game events that advance the game. I find that the gap between the description of the SportsChannel editing methods and Appellants’ editing method “is simply not so great as to render the system nonobvious to one reasonably skilled in the art.” *Dann v. Johnston*, 425 U.S. 219, 230 (1976). In my view the evidence supports the Examiner’s finding that game advancing action would have been of interest, and that editing the recording to include substantially only the game advancing action would have been obvious.

My colleagues found there was no reason for a creative person of ordinary skill to edit to shorten the game but include “boring” game elements. I disagree. The Examiner’s finding that a person of ordinary skill in the baseball editing art knew which actions were “game advancing” was a reason. Whether the action was boring or not, the action advanced the game, which would have motivated its selection by an editor having ordinary skill and knowledge.

[T]he question is . . . not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available. . . . Far from requiring that a disclosed combination be preferred in the prior art in order to be motivating, this court has held that “[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use” Thus, a finding that the prior art as a whole suggests the desirability of a particular combination need not be

supported by a finding that the prior art suggests that the combination claimed by the patent applicant is the preferred, or most desirable, combination.

In re Fulton, 391 F.3d 1195, 1200 (Fed. Cir. 2004) (citations omitted).

Appellants argue that Major League Baseball (MLB) promoted and used the claimed method and this is evidence of commercial success. (App. Br. 17-18.) MLB's press release of March 5, 2002 "announced the debut of a revolutionary new baseball video service," referred to the service as "another first-of-its-kind baseball subscription service," and called it *MLB.com Condensed Games*. (Evid. Apdx.) According to the press release, "[t]he price of the new *Condensed Game* service will be announced shortly." (*Id.*) The press release is evidence that MLB planned to offer the service to subscribers, but it is not evidence of that any subscribers bought the service. Without evidence of sales, Appellants' assertion of commercial success should receive little weight. There is no way to assess whether sales have occurred, and if any, whether they represent a substantial quantity in the market. *See Huang*, 100 F.3d at 140.

Appellants ask "if the claimed method was simply an obvious design choice, why then did Major League Baseball call it 'revolutionary?'" (App. Br. 16.) The Examiner found MLB's press release exaggerated and gave its characterizations little weight because the "use of hyperbole is well-known in the advertising art." (*Id.* at 17, quoting the Examiner's Office Action of June 28, 2005 at pp. 9-10.) Appellants objects that "whether an advertising statement is hyperbole or not is irrelevant," and that "the Examiner is in no position to make such conclusion." (*Id.*) In my view the Examiner was correct to give little weight to the press release characterization. Our

reviewing court cautions that advertising is not given the weight that objective evidence of commercial success receives. *See, e.g., McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1370 (Fed. Cir. 2003) (advertising may obscure a nexus that exists between the merits of a product and its commercial success).

CONCURRING-IN-PART AND DISSENTING-IN-PART

lp

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON DC 20005-4051